

REMARKS/ARGUMENTS

35 USC 102(b)

Claims 1-2, 14-15 were rejected under 35 U.S.C. § 102(b) as being anticipated by Stanek et al. (as cited in the record). The applicant respectfully disagrees for at least the reasons discussed below. The applicant also hereby makes amendments to the claims in view of the Examiner's comments. Applicant respectfully submits that the amendments to the claims traverse this rejection.

The 35 U.S.C. §102(b) states the following:

“A person shall be entitled to a patent unless
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States”

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (MPEP § 2131). As can be gleaned from the cited case law, the requirement is that each element must be either expressly or inherently described.

Cited Reference Does Not Disclose Every Recited Limitation

The currently amended claim 1 recites the following limitations:

“A method of inducing angiogenesis in a subject, comprising administering to a subject a medicament containing alprostadil so as to induce angiogenesis in the subject, and wherein the method does not include an incremental dose of 40 ng/kg/min.”

The cited reference does not disclose **wherein the method does not include an incremental dose of 40 ng/kg/min.** In the currently amended claims, the claim methods specifically disclaim an incremental dose of 40 ng/kg/min.

As such, withdrawal of the 102(b) rejection on claims 1-2, 14-15 based on the Stanek reference is respectfully requested.

Patent Examiners Should Interpret Claims in Light of Specification

The court has recently indicated that the PTO should apply the principles of *Phillips v. AWH* during prosecution — rather than the PTO’s current practice of giving claims their “broadest reasonable interpretation.” *In re Johnston* (Fed. Cir. 2006). The Patent Office may use a dictionary in defining the patent applicant’s claim terms only when the patent specification did not otherwise provide any interpretation.

Teaching Away

Furthermore, the Federal Circuit has indicated that one important indicium of nonobviousness is “teaching away from” the claimed invention by the prior art, and has reversed rejections of claims where it found that prior art references applied by the PTO in fact teaching away from what was being claimed. Therefore, an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553).

According to MPEP 2141.02 and 2143.01, prior art must be considered in its entirety, including disclosures that teach away from the claims, and that proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. Further, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

The Stanek reference teaches away from administered to the subject via a central right-heart catheter with an initial dose of 2.5 ng/kg/min, and then increased “**to the maximally tolerated dose (MTD) of 29 ± 1 ng/kg/min., and does not include an incremental dose of 40 ng/kg/min.**” Stanek requires the administration of incremental doses **including 40 ng/kg/min.**

The Office is also respectfully reminded that proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Furthermore, “[k]nown disadvantage in old devices which would naturally discourage

search for new inventions may be taken into account in determining obviousness.” *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966).

New Claim

New claim 16 has been added, and contains no new matters.

Request For Allowance

Claims 1-16 are pending in this application. The applicant expresses his gratitude to the Examiner for the courtesies extended to Applicant’s undersigned representative throughout prosecution of this application. In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested. Favorable consideration is respectfully requested.

Respectfully submitted,
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